

REMARKS

Claims 1-62 are pending. Claims 1, 15, 30 and 44 were amended to delete new language added in the previous amendment thereby returning these claims to the same state as they were in immediately prior to the filing of the RCE. Claims 7, 9, 10, 21, 23, 24, 36, 38, 39, 50, 52 and 53 were amended to address the rejection under 35 USC § 112, second paragraph.

Withdrawal of all rejections is respectfully requested for at least the reasons set forth below.

35 USC § 112, first paragraph, rejection

The Examiner objected to the new limitation added to each of the independent claims in the previous amendment. As stated in the previous amendment, no new matter was added by this amendment because it is an inherent characteristic of the assets referred to in the claimed invention that their taxable status are “considered fixed over time and not dependent upon the holding period of the asset” since their taxable status are determined by the types of accounts in which they are held. Nonetheless, Applicants have canceled the new limitation, thereby rendering this rejection moot.

35 USC § 112, second paragraph, rejection

The Examiner rejected claims 7, 8, 21, 22, 36, 37 and 50 as allegedly being indefinite because of the phrase, “possibly repositionable assets.” In response to this rejection, the word “possibly” was changed to “conditionally” throughout the claims. No new matter was added by this word change. The specification clearly describes that “possibly repositionable assets” are assets that could be repositioned if certain conditions are met, in contrast to “non-repositionable assets” and “repositionable assets.” See, for example, page 23, line 23 through page 24, line 2 of the specification which reads as follows:

3. Possibly Repositionable -

Are assets needed to reach target SAA?

If no, do not reposition. If yes, reposition based on conditionality.

Possibly repositioned assets will be constrained by client preferences, tax costs and redemption fees. Whether or not these assets will be moved to Vanguard will be determined by the counselor. These possibly repositioned assets will be run as non-repositionable at first. If the target SAA is not met then the counselor will re-run the plan with certain assets as repositionable or because of constraints leave the assets alone.

Withdrawal of this rejection is respectfully requested in view of the claim rewording.

35 USC § 103(a) rejection

Claims 1-62 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,161,098 (Wallman) in view of U.S. Patent No. 6,601,044 (Wallman). Withdrawal of this rejection is respectfully requested for at least the reasons set forth below.

Although Applicants believe that this rejection is an improper hindsight reconstruction of the present invention, Applicants nonetheless submit herewith a Declaration under 37 C.F.R. §1.131 that establishes completion of the present invention at a date prior to September 14, 1998, which is the effective date of Wallman '098.

Accordingly, Wallman '098 cannot be prior art against the present invention. For this reason, the Examiner's rejection of claims 1-62, which relies upon Wallman '098 for a disclosure of at least elements and steps (a), (c), (d) and (e), must be withdrawn. Furthermore, Wallman '044 does not make up for this deficiency.

Conclusion

Insofar as the Examiner's rejections were fully addressed, the instant application is in condition for allowance. A Notice of Allowability of all pending claims is therefore earnestly solicited.

Respectfully submitted,

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